

REMARKS

Applicant respectfully acknowledges receipt of the Office Action mailed March 23, 2006.

In the Office Action, the Examiner (1) rejected claims 1, 2, and 6-8 under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* (U.S. Patent No. 5,721,623) in view of *Stemme* (U.S. Patent No. 4,344,683); (2) rejected claims 3-5, 9-11, and 33-36 under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* in view of *Stemme*, and further in view of *Pourjavid* (U.S. Patent No. 5,883,985); (3) rejected claims 12-15 and 37 under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* in view of *Stemme*, and further in view of *Agano* (U.S. Patent No. 6,573,507); (4) rejected claims 16-18 under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* in view of *Stemme*, further in view of *Agano*, and further in view of *Pourjavid*; (5) rejected claims 19-21 under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* in view of *Stemme*, and further in view of *Ozaki* (U.S. Patent No. 5,896,202); (6) rejected claims 22-24 under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* in view of *Stemme*, further in view of *Ozaki*, and further in view of *Pourjavid*; (7) rejected claims 25, 26, and 28 under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* in view of *Stemme*, and further in view of *Pourjavid*; (8) rejected claim 27 under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* in view of *Stemme*, further in view of *Pourjavid*, and further in view of *Agano*; and (9) objected to claims 29 and 51 as being dependent upon a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

By this Amendment, Applicant amends claims 1 and 29 to improve clarity and/or better define the claimed invention. After entry of this Amendment, claims 1-54 and 58 will remain pending. Of these claims, claim 1 is independent.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claims 1 and 29. No new matter has been introduced.

Applicant gratefully acknowledges the Examiner's indication of allowable subject matter in claims 29 and 51 if rewritten in independent form. Consequently, Applicant has amended claim 1 to include a feature of allowable claim 29. Accordingly, independent claim 1 is in condition for allowance. In addition, claims 2-54 and 58 are in condition for allowance at least due to their dependence from independent claim 1.

Based on the foregoing amendments, Applicant traverses each of the above rejections and respectfully requests reconsideration for the reasons that follow.

I. 35 U.S.C. § 103(a) REJECTIONS

Claims 1, 2, and 6-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* in view of *Stemme*. Applicant respectfully disagrees with the Examiner's arguments and conclusions and submits that independent claim 1 is patentably distinguishable over *Boxma* and *Stemme* at least for the reasons set forth below.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must "be found in the prior art, and not be based on Applicants' disclosure." See MPEP § 2143, 8th ed., February 2003.

Boxma discloses a calibration method and device for adjusting a hard-copy-unit (HCU), wherein the HCU records medical images on a film. To correct for the deterioration of the image quality of the film, a hard copy of the film is made, with a number of predetermined grey values, and the resulting optical densities on the hard copy are measured. From the resulting optical density values, new brightness (B) and contrast (C) parameters are determined that will result in the correct maximum and minimum optical densities of subsequently exposed and processed images on the film (emphases added). (*Boxma*, Abstract and col. 2, ll. 23-27). As admitted by the Examiner, however, "*Boxma* fails to expressly disclose that the printing section prints at least one of a sharpness-evaluating test pattern and a granularity-evaluating test pattern." (*Office Action*, p. 2, line 16-18). Additionally, *Boxma* fails to teach or suggest where the sharpness-evaluating test pattern includes at least four kinds of pattern elements.

Accordingly, *Boxma* necessarily fails to teach or suggest the claimed combination including, *inter alia*:

"wherein said printing section prints at least one of a sharpness-evaluating pattern and a granularity-evaluating pattern, and wherein said sharpness-evaluating pattern includes at least four kinds of pattern elements," as recited in amended claim 1 (emphases added).

Thus, in order to cure the deficiencies of *Boxma*, the Examiner relies on *Stemme* for an alleged disclosure of “printing...a sharpness-evaluating test pattern along with a photographic image on a film.” (*Id.* at p. 2, ll. 18-20). Applicant notes, however, that *Stemme* does not teach or suggest, among other things, “wherein said printing section prints at least one of a sharpness-evaluating pattern and a granularity-evaluating pattern, and wherein said sharpness-evaluating pattern includes at least four kinds of pattern elements,” as recited in amended claim 1 (emphasis added).

Rather, *Stemme* discloses a quality control method and apparatus for photographic pictures, which includes a positive photographic paper picture 1 with a test pattern 2 provided in its margin. The part of the test pattern 2 which is important resides in zones 2d, 2e, and 2f. Each zone carries a raster pattern of different frequency. A single glance suffices to show whether or not the finest of the rasters is sharp or not. (*Stemme*, col. 3, ll. 33-45). *Stemme*, however, fails to disclose wherein the test pattern 2 includes at least one of a granularity-evaluating pattern and wherein the sharpness-evaluating pattern includes at least four kinds of pattern elements.

Accordingly, with respect to independent claim 1, *Boxma* and *Stemme* fail to teach or suggest the claimed combination, including, *inter alia*:

“wherein said printing section prints at least one of a sharpness-evaluating pattern and a granularity-evaluating pattern, and wherein said sharpness-evaluating pattern includes at least four kinds of pattern elements” (emphases added).

The Examiner has therefore not met at least one of the essential criteria for establishing a *prima facie* case of obviousness, wherein “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See

M.P.E.P. § 2143. Accordingly, independent claim 1 is patentable over *Boxma* and *Stemme*. Applicant therefore requests that the rejection of claims 1, 2, and 6-8 under 35 U.S.C. §103(a) be withdrawn and claims 1, 2, and 6-8 be allowed.

Applicant respectfully traverses the Examiner's rejection of claims 3-5, 9-11, and 33-36 under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* in view of *Stemme*, and further in view of *Pourjavid*; the rejection of claims 12-15 and 37 under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* in view of *Stemme*, and further in view of *Agano*; the rejection of claims 16-18 under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* in view of *Stemme*, further in view of *Agano*, and further in view of *Pourjavid*; the rejection of claims 19-21 under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* in view of *Stemme*, and further in view of *Ozaki*; the rejection of claims 22-24 under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* in view of *Stemme*, further in view of *Ozaki*, and further in view of *Pourjavid*; the rejection of claims 25, 26, and 28 under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* in view of *Stemme*, and further in view of *Pourjavid*; and the rejection of claim 27 under 35 U.S.C. § 103(a) as being unpatentable over *Boxma* in view of *Stemme*, further in view of *Pourjavid*, and further in view of *Agano*.

Pourjavid, *Agano*, and *Ozaki* all fail to overcome the above noted shortcomings of *Boxma* and *Stemme*. Accordingly, claims 3-5, 9-54 and 58 are allowable at least due to their corresponding dependence from allowable independent claim 1.

II. CONCLUSION

Applicant respectfully submits that independent claim 1 is in condition for allowance. In addition, claims 2-54 and 58 are in condition for allowance at least due to their dependence from independent claim 1.

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 23, 2006

By: /David W. Hill/
David W. Hill
Reg. No. 28,220